

### **REMARKS**

This amendment is responsive to the final Office Action dated July 20, 2005. Notice of appeal was filed on January 20, 2006. Claims 17-34 are pending. By submitting this amendment and RCE, Applicant is presenting amended claims and will be filing a supplemental information disclosure to continue prosecution of this application. Specifically, claims 17, 28, 32-34 are amended.

#### **Discussion of Proposed Changes - Withdrawn**

In paragraph 2.1 of the office action, the Examiner maintains his rejections based on the grounds that the proposed changes introduce new matter and should be withdrawn. Applicant disagrees that the proposed changes introduce new matter and has indicated the reasoning why such allegations are baseless. Nonetheless, Applicant withdraws the proposed changes to conclude prosecution of this application.

#### **(i) PROPOSED DRAWING CHANGE, Figure 2;**

The Examiner objects to the requested drawing change in the block "TS" from "DIAL-UP PUBLIC TELEPHONE SYSTEM" to "COMMUNICATION SYSTEM/DIAL-UP PUBLIC TELEPHONE SYSTEM," on the basis that the change is unduly broadening. Specifically, the Examiner expressed concern with respect to such communication systems as "internet telephone," "wireless," etc. Respectfully, such forms of communication are explicitly set forth in Applicant's specification. The objective of the proposed drawing modification was to indicate a functional COMMUNICATION SYSTEM that may be embodied as a DIAL-UP PUBLIC TELEPHONE SYSTEM. Specifically, Applicant's specification indicates the use of "personal computers" that accomplish on-line communication thereby indicating computers that may access the internet (see page 6, line 28). More specifically, at page 8, beginning on line 15, the specification indicates several communication systems alternatives, again, including "desktop PCs" (personal computers). Additionally, "electronic bulletin boards", on-line computer services and other communication systems are mentioned. With regard to "wireless" communication systems, at page 15, line 28, the specification mentions "cellular telephone." The Examiner chooses to disregard these examples in the specification, making the argument that the specification, at page 15, lines 28, only teaches a manual use of cellular or regular phone when

the TIS is having complications. From this, the Examiner assumes that the cellular phone is not part of the specified dial-up public telephone system based TIS. If Applicant's specification did not anticipate use of wireless communications, to make any mention of a cellular phone, in any context, would have been a useless exercise.

The Examiner is reminded that an inventor's burden is only to describe an illustrative embodiment of the invention and not every variation of every technical aspect that contributes to the environment in which the invention is practiced.

Still, another form of a communication system is indicated at page 31, line 6, by a reference to a "private network." Still further, the text at page 34, lines 34-35, recognizes the possibility "for a wide variety of communications to the dial-up telephone system TS." In view of the above specific disclosures of various communications systems, it is respectfully submitted that adequate disclosure exists for a "communication system," while indicating the exemplary embodiment as a "dial-up telephone system." However, if the Examiner is resistant, Applicant withdraws the proposed change, while making a record of the various examples that were clearly contemplated.

**(ii) PROPOSED PRIOR AMENDMENT, page 6, line 13, change "effectively prevents" to "also avoids."**

In Applicant's disclosed system, merchandise classifications and their attendant processing accomplish several functions, including controlling and regulating select communications between vendor and buyer terminals on the basis of merchandise (page 37, lines 25-26; page 45, line 8). Such operations also include:

(1) Qualification (page 32, line 13; page 41, line 33):

In view of the specific disclosures indicated above, a proposed cosmetic amendment at page 6 is intended merely as an alerting comment to the multiple criterion of "selective routing." The Examiner's attempt to draw differences between "effectively prevents" and "also avoids," is unclear.

**(iii) PROPOSED PRIOR AMENDMENT, page 11, line 3 (7-8).**

The objective of the proposed cosmetic amendment is with respect to the system depicted in Figure 5 and specifically, the "TRAFFIC CONTROL" system which appears broadly in

Figure 2. In that regard, the traffic control system as labeled does not include the word "central." Consequently, it was deemed appropriate to delete the word "central" from the text in line 3. Furthermore, the total system of Figure 2 accomplishes far more than "scheduling and routing" (page 11, line 8). Specifically, the total system of Figure 2 involves alternative communication facilities (format switch), selectively, data storage, operator alternative, and on and on. Consequently, it is deemed appropriate and proper to delete the terms "scheduling and routing,"

Finally, with regard to page 11, line 7, the addition of the words "a form of" is appropriate in relation to the other changes indicated above. Clearly, it is understood that any disclosed embodiment is "a form of" an illustrative system.

**(iv) PROPOSED PRIOR AMENDMENT, page 19, line 2.**

The Office Action states: "The disclosure does not show that TIS carries out filtering of vendors...".

Figure 2 discloses the broad system TIS. Figure 5 is in more detailed block diagram of the traffic control system of Figure 2, i.e. TIS (page 11, line 3). Figure 6 is a flow diagram illustrating an operation of the system that Figure 5, i.e. TIS (page 11, line 6).

The qualification unit T28 (Figure 5) functions to limit or select buyers and vendors (page 37, line 3). Accordingly, the cosmetic change requested at page 19, being consistent with the disclosure, is submitted simply for that reason. If the Examiner does not permit this change, Applicant will continue use of the term "selecting" to convey the same meaning.

**(v) PROPOSED PRIOR AMENDMENT, page 24, lines 7 and 8.**

Similar cosmetic changes requested regarding the term "filtering" were treated above and on that basis are deemed appropriate.

**(vi) PROPOSED PRIOR AMENDMENT, page 33, line 4; reconsideration requested.**

The cosmetic change of the term "and" is, again, sought for the purpose of indicating the system functions of using merchandise codes to both select routing and to avoid information overload. Applicant's system clearly discloses the function of "selectivity" and therefore, the attendant additional function of combating overload. The cosmetic change requested is submitted to be clearly in accord. Of course, the selectivity logic, as treated above, also involves the operation of qualification. The quoted specification language in the Office Action does not

seem to be inconsistent with the requested cosmetic changes. Similar comments are applicable to the operation of the cosmetic change entered on page 37, line 9.

**(vii and viii) PROPOSED PRIOR AMENDMENT, page 41, line 10 and page 45, line 2.**

“The selection process” relating to merchandise is a criteria based on which vendors are selected. The specification emphatically supports the request by operation of the selection structure.

Given the Examiner’s resistance to the proposed changes (for reasons that are unclear), Applicant withdraws the proposed changes. The specification on its face clearly supports reasons for requesting the proposed changes.

#### Discussion of Section 112 Rejections

In paragraph 3 of the office action, the Examiner rejected claims 32-34 under 35 U.S.C. Section 112, first paragraph. With regard to claims 32-34, the Examiner takes the position that the specification does not disclose *“filter means for processing RFPs meeting a first set of selection conditions and accepting quotes from sellers meeting said first set of selection conditions and selecting said quotes so that only quotes meeting additional selection conditions are sent to a buyer requesting said quotes.”* Instead, the Examiner reads the specification in an unduly restrictive way, indicating that *“the vendor is already selected/designated/specified by the buyer when he forwards the request, and this request for proposal with the already designated/selected vendor from buyer reaches the selectivity logic 47 in the TIS – the filter means claimed by the applicant (see amendment page 9, line 15-page 10, line 2, “....Functionally the operation is performed by the central traffic control system TIS....the selectivity logic 47...and occasionally the Unit P28”), which enhances the selection of calls/communication between buyers and vendors based upon data such as DNIS, ANI and numerical merchandising codes like 47000, to assist TIS, to determine and properly direct communications between already selected/designated/specified buyers and vendors to prevent information overload (see at least page 23-24, paragraph 0076, page 37, paragraph 01115.”* Returning to the routine situation, as indicated above, each buyer and vendor is associated with specific merchandise codes...merchandise codes not only facilitate and expedite

*communication...” explicitly teaches that both selected buyers and vendors are associated with a common merchandise code. FIG. 9, and page 44, paragraph 0135, lines 23-35 explicitly discloses that the buyer specifies this merchandise code in the request for proposal before the request reaches selectivity logic 47/central traffic control system TIS and the merchandise code itself is indicative of the selected vendor and also of the fact that mere routing of the request for purchase communication is carried out by the selectivity logic 47/TIS and not selecting of unspecified vendors to select vendors based upon conditions stated in the request.”*

The Examiner recites the entire claim, taking the position that it is not supported and makes the statement that “[i]nstead, the specification teaches that the vendor is already selected/designated/specified by the buyer when he forwards the request, and this request for proposal with the already designated /selected vendor from the buyer reaches the selectivity logic 47 in the TIS-the filter structure claimed by the applicant....”

Indeed, if the vendor was already selected as urged by the Examiner, the role of Applicant’s central traffic system would be different than what is described by Applicant’s specification. By way of one example, the buyer may simply send a request that relates to particular merchandise. It is the central traffic control system that determines a list of vendors to whom the request should be routed. The central traffic system may utilize “merchandise codes” that identify the vendors listed for particular merchandise to select a final list of vendors to whom the request should be routed. The class of the vendor is a criteria of selection (page 38, line 23). Applicant's system is described to involve additional criteria, member identification (page 39, line 31); special information (page 41, line 32); select groups (page 44, line 25); and so on. Of course, qualification is widely mentioned.

The Office Action asserts that Applicant's system does not enable a buyer to select criteria which accomplishes a connection with a particular vendor, contending the selection is made as part of the request. The undersigned does not understand such a position. Clearly, the extensive treatment of merchandise codes (page 37) and the selectivity operations expressly indicate the criteria of pre-established conditions which accomplish selective communication (see page 1, line 25; page 5, line 18; page 6, line 9; page 8, line 12; page 12, line 21; page 15, line 15; page 24, lines 6, 11; page 33, line 12; page 37, line 18; page 38, lines 20, 27). Further, with regard to routing see page 7, line 4, 16, 25, 31; and page 18, line 12.

In the Office Action, reference is made to page 9 of the last amendment; however, the passage clearly indicates that the selections are made "in accordance with the merchandise codes."

Also, reference is made to page 41 of the specification and the comment regarding merchandise codes. Clearly, Applicant's system of merchandise codes is an explicit description of the manner in which communication may be selectively accomplished on the basis of "goods," just as described broadly in the '328 patent. Essentially, the '328 patent does not explain the detail of accomplishing communication based on the nature of the "goods" (col. 5, line 44; col. 7, line 11), but rather leaves the matter undisclosed. On the contrary, Applicant discloses a system of merchandise codes whereby processing is accomplished to perform the selection or filter operation.

Reference is also made to the operation in Applicant's system with the attendant operation "to prevent information overload" (page 24, line 8). It is understood that any selectivity or filtering, which expedites a desired connection from a multitude of possibilities has the effect of preventing information overload. The mere statement of that advantage clearly is not a limiting consideration.

In paragraph 4, claim 34 is rejected under 35 U.S.C. Section 112, as being indefinite because it recites the limitation "selection structure," which does not have antecedent basis. Claim 34 is amended to address that rejection. \*

#### Discussion of the 35 U.S.C. Section 102 Rejection

In paragraph 5 of the office action, the Examiner rejected claims 20-27 under 35 U.S.C. Section 102(e) as being anticipated by Spiegelhoff et al. The Examiner made this rejection, only with consideration of the elements that he believed are supported by the specification, excluding the "filter" limitations. The claims, as further amended, recite "selection" and "processing" limitations that are clearly supported by the specification. With consideration of these limitations, the Examiner should find that the claims here are quite distinct from Spiegelhoff et al.

In paragraph 6 of the office action, the Examiner rejected claims 28 and 30-31 under 35 U.S.C. Section 102(e) as being anticipated by Shavit et al. Again, the Examiner urges this rejection, only with consideration of the elements that he believes are supported by the specification, excluding the “filter” limitations. The claims, as further amended, recite “selection” and “processing” limitations that are clearly supported by the specification. With consideration of these limitations, the Examiner should find that the claims here are quite distinct from Shavit et al.

#### Discussion of the 35 U.S.C. Section 103 Rejection

In paragraph 7 of the office action, the Examiner rejected claims 17-19 under 35 U.S.C. Section 103 as being unpatentable over Shavit et al. in view of Maloney et al. Again, the Examiner urges this rejection, only with consideration of the elements that he believes are supported by the specification, excluding the “filter” limitations.

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 The establishment of a *prima facie* case of obviousness requires that the claimed combination cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose. MPEP § 2143.03

To resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper. *In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002); *In re Deminski*, 796 F.2d 436, 442 (Fed. Cir. 1986)). Rather, obviousness is to be determined from the vantage point of a hypothetical person having ordinary skill in the art to which the patent pertains. See 35 U.S.C. § 103(a). The legal construct also presumes that all prior art references in the field of the invention are available to this hypothetical skilled artisan. *In re Carlson*, 983 F.2d 1032, 1038, 25 USPQ 2d 1207, 1211 (Fed. Cir. 1993).

An Examiner may often find every element of a claimed invention in the prior art. “Virtually all [inventions] are combinations of old elements.” *Environmental Designs, Ltd. V.*

Application No.: 09/505,913  
Reply to final Office Action of: July 20, 2005

*Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed.Cir. 1983); see also *Richel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed.Cir. 1983). If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be “an illogical and inappropriate process by which to determine patentability.” *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 U.S.P.Q.2d 1551, 1554 (Fed.Cir.1996). In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

The Examiner is urged to reconsider his rejections under 35 U.S.C. Section 103 based on the case law cited above. In addition, the claims, as further amended, recite “selection” and “processing” limitations that are clearly supported by the specification. With consideration of these limitations, the Examiner should find that the claims here are quite distinct from the combination of Shavit et al. and Maloney as suggested by him.

In paragraphs 8 and 9, claims 29 and 32-34 are rejected as being unpatentable over Shavit et al. and Maloney. Claim 29 depends from claim 28, which recites a selection feature that is absent in Shavit. Claims 32-34 also recite the same selection feature.

Favorable consideration and allowance of the claims pending here is respectfully requested.

Respectfully submitted,

Dated: May 22, 2006

By: /Reena Kuyper/

Reena Kuyper

Registration No. 33,830

9255 Sunset Blvd., Suite 810

Los Angeles, CA 90069

(310) 247-2860